

## REMARKS

### **I. Formalities**

Claims 1-36 remain in the subject patent application. No amendments are made herein. Accordingly, Applicants respectfully submit that no new matter is added herein.

### **II. Remarks Directed to the Double Patenting Rejection**

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~~Claims 1-30 and 33-36 stand rejected under the judicially-created doctrine of double~~  
patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,429,685 since the claims, if allowed, would allegedly “improperly extend the ‘right to exclude’ already granted in the patent.” As the Office Action indicates, a timely filed terminal disclaimer in compliance in 37 C.F.R. 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground, provided the conflicting application or patent is shown to be commonly owned with this application.

Attached is a copy of the notice of recordation of assignment, and the recorded assignment itself, indicating that the inventor of the invention disclosed in Patent Application Serial No. 09/711,486 has assigned all of his right, title, and interest in the invention, together with all continuations, continuations in part, and divisionals, to Gain Technology Corporation. U.S. Patent No. 6,429,685 issued from Patent Application Serial No. 09/711,486. Patent Application Serial No. 10/081,821, to which the present Office Action is directed, is a continuation-in-part application of Patent Application Serial No. 09/711,486. Thus, Patent Application Serial No. 10/081,821 and U.S. Patent No. 6,429,685 have been assigned to Gain Technology Corporation.

Gain Technology Corporation, an Arizona corporation, has been re-incorporated as SMSC Analog Technology, Inc., also an Arizona corporation. Attached are copies of: (1) the notice of recordation of assignment, and the recorded assignment itself, indicating that Gain Technology Corporation assigned all of its right, title, and interest in U.S. Patent No. 6,429,685

to SMSC Analog Technology, Inc.; and (2) the notice of recordation of assignment, and the recorded assignment itself, indicating that Gain Technology Corporation assigned all of its right, title, and interest in Patent Application Serial No. 10/081,821, to SMSC Analog Technology, Inc. Accordingly, SMSC Analog Technology, Inc. owns both the present application and U.S. Patent No. 6,429,685.

Also attached is a terminal disclaimer believed to comply with the requirements of 37 C.F.R. 1.321(c). Because the terminal disclaimer has been filed, it is respectfully believed that the double patenting rejection of claims 1-30 and 33-36 is overcome and should be withdrawn.

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**III. Remarks Directed to Claims 1-30 and 33-36**

In view of the expected withdrawal of the double patenting rejection, it is respectfully believed that claims 1-30 and 33-36 are now in condition for allowance.

**IV. Remarks Directed to Claims 31-32**

Claims 31 and 32 were rejected under 35 U.S.C. §102(b) as being allegedly anticipated by United States Patent No. 5,254,883 to Horowitz et al. (hereinafter "Horowitz"). These rejections are respectfully traversed in view of the remarks made hereinbelow.

Anticipation requires each element of a claimed invention to be disclosed in a single reference. Disclosure cannot be predicated on teachings in a reference that are vague or based upon conjecture. It is respectfully submitted that silence in a reference is not a proper substitute for an adequate disclosure of facts from which a conclusion of anticipation may justifiably follow. A proper anticipation rejection under 35 U.S.C. §102 requires that each element of a claimed invention be disclosed in a single reference having the same elements, united in the same way, and performing the same function.

**A. Remarks Directed to Claim 31**

Claim 31 requires an integrated circuit comprising a voltage-mode driver circuit having an integral, analog on-chip termination. In contrast, Horowitz discloses a current-mode driver having a mixed signal on-chip termination. Furthermore, Horowitz teaches away from the voltage-mode driver requirement of claim 31 at, for example, column 1, line 48, to column 2, line 2, where voltage-mode drivers are discussed in a negative light and current-mode drivers are discussed in a positive light. Additional evidence of the fact that Horowitz teaches away from a voltage-mode driver as required by claim 31 can be found: (1) in the "Summary and Objects of the Invention" section Horowitz, where all six listed objects of the invention refer to current-mode drivers and not to voltage-mode drivers; and (2) in the Brief Description of the Drawings section, where current-mode drivers are referred to three times, and where voltage-mode drivers are not mentioned at all. ~~Claim 31 is therefore allowable for at least this reason.~~ Accordingly, Applicant respectfully requests that the rejection of claim 31 be withdrawn, and that claim 31 be allowed.

**B. Remarks Directed to Claim 32**

Dependent claims must be construed to include all of the limitations of the claims from which they depend, as required by 37 C.F.R. 1.75(c) and M.P.E.P. 608.01(n). Therefore, claim 32, which depends from claim 31, is also not anticipated by Horowitz for at least the same reasons as listed earlier for claim 31. Therefore, claim 32 is allowable for at least this reason. Accordingly, Applicant respectfully requests that the rejection of claim 32 be withdrawn, and that claim 32 be allowed.

### CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. In light of the remarks set forth hereinabove, Applicant respectfully requests reconsideration and allowance of all of the pending claims.

No fees are believed to be due in connection with this Response to Office Action. However, the Commissioner for Patents is hereby authorized to charge any fees required by this Response to Office Action, or credit any overpayment, to Account No. 02-4467.

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If there are matters that can be discussed by telephone to further the prosecution of this application, Applicant invites Examiner Don P. Le to call the undersigned attorney at the Examiner's convenience.

Respectfully submitted,



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